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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/752,205	01/06/2004	John L. White	P214492	2625

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SCHACHT LAW OFFICE, INC.
SUITE 202
2801 MERIDIAN STREET
BELLINGHAM, WA 98225-2412

EXAMINER

LEE, JONG SUK

ART UNIT	PAPER NUMBER
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3673

DATE MAILED: 09/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/752,205

Applicant(s)

WHITE, JOHN L.

Examiner

Jong-Suk (James) Lee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>4/16/2004</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities:

Page 1, line 9: -- , now U.S. Patent No. 6,672,805 -- should be inserted after "filed on 09/27/2002".

Appropriate correction is required.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 3, 4, 8-12 and 14-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Japanese Patent Application (JP5 56-34828).

Japanese Patent Application'828 discloses a method and device for driving steel plate cell/caisson comprising a plurality of vibratory devices(3), where each vibratory device generates a vibratory force; a clamp/chuck assembly (4) for rigidly securing each of the vibratory devices to one of a plurality of predetermined angularly spaced locations about the caisson (1), and a timing system (7) operatively connecting the plurality of vibratory devices to synchronize the

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vibratory forces generated thereby, in which the timing system including at least one gear box (see Fig. 3), and a plurality of shafts (19), where each shaft extends between one of the vibratory devices and the at least one gear box (12), and operation of one of the vibratory devices causes operation of another of the vibratory devices through the at least one gear box and the plurality of shafts such that the vibratory forces generated by the vibratory devices are synchronized, the system further comprising a crane assembly (26), and a suspension assembly (21-24) connected between the crane assembly and the vibratory devices for inhibiting transmission of vibratory forces to the crane assembly, in which the timing system interconnects the vibratory devices in a daisy chain configuration (see Fig. 2) to synchronize the vibratory forces generated by the vibratory devices, in which each vibratory device inherently comprises at least two eccentric weights, and the timing system is operatively connected between the vibratory devices such that the eccentric weights rotate at substantially the same speed (see Figs. 1-3; based on English Translated Abstract).

Obviousness-Type Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground

provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-11 and 17-19 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-10 and 17-19 of U.S. Patent No. 6,672,805.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the present claimed invention is somewhat broader recitation of the '805 Patent, for example, in claims 1 and 4 of present claimed invention and claim 1 of '805 Patent, the Applicants claim:

"a plurality of vibratory devices, where each vibratory device generates a vibratory force; a clamp assembly for rigidly securing each of the vibratory devices to one of a plurality of predetermined angularly spaced locations about the caisson, and a timing system operatively connecting the plurality of vibratory devices to synchronize the vibratory forces generated thereby" as recited in claim 1; and

"a crane assembly (26), and a suspension assembly (21-24) connected between the crane assembly and the vibratory devices for inhibiting transmission of vibratory forces to the crane assembly." as recited in claim 4.

Whereas in '805 Patent, the Applicants claim " a crane assembly; a plurality of vibratory devices, where each vibratory device generates a vibratory force; a clamp assembly for rigidly

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securing each of the vibratory devices to one of a plurality of predetermined angularly spaced locations about the caisson; a suspension assembly for connecting the vibratory devices to the crane assembly such that transmission of vibratory forces from the vibratory devices to the crane assembly is inhibited; and a timing system operatively connecting the plurality of vibratory devices to synchronize the vibratory forces generated thereby" (see col.3, lines 46-61).

Therefore, in respect to above discussions, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the teachings of claim 1-10 and 17-19 of '805 Patent as a general teachings for a caisson driving system and method as claimed by the present application. The instant claims obviously encompass the claimed invention of '805 Patent and differ only in terminology. To the extent that the instant claims are broaden and therefore generic to the claimed invention of '805 Patent [species], *In re Goodman* 29 USPQ 2d 2010 CAFC 1993, states that a generic claim cannot be issued without a terminal disclaimer, if a species claim has been previously been claimed in a co-pending application.

Statutory Type Double Patenting

6. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The

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filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

7. Claims 12-16 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 12-16 of prior U.S. Patent No. 6,672,805. This is a double patenting rejection.

Allowable Subject Matter

8. Claims 2, 5-11, 13, 18 and 19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims and **upon timely filing Terminal Disclaimer**.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Other references cited disclose a machine suspended from a crane or similar device for driving and extracting piling, a sonic drilling method and apparatus and a subsurface barrier wall and method of installation.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jong-Suk (James) Lee whose telephone number is (703) 308-6777. The examiner can normally be reached on 6:30 am to 3:00 pm, Monday thru Friday.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather C. Shackelford, can be reached on (703) 308-2978. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

J. Lee /jjl
September 7, 2004



Jong-Suk (James) Lee
Primary Examiner
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